

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
BERT W. ELLIOTT)	Group Art Unit: 3633
)	
Serial No.: 10/664,552)	Examiner: Jeanette E. Chapman
)	
Filed: September 18, 2003)	Confirmation No.: 4288
)	
For: LAMINATED STARTER SHINGLE)	Attorney Docket: 25244A
FOR A ROOF COVERING)	

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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41 and § 41.43

This paper is responsive to the Examiner's Answer dated September 29, 2009, setting a reply date of November 29, 2009. This paper is timely filed, and it is believed that no fee is required.

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I. Status of Claims

Claims 5, 13-14, 21, 28-30 and 32-40 are finally rejected. Claims 1-4, 6-12, 15-20, 22-27 and 31 are cancelled. Claims 5, 13-14, 21, 28-30 and 32-40 are appealed.

II. Grounds of Rejection to be Reviewed on Appeal

Grounds of rejection are set forth in the Advisory Action dated October 20, 2008 and the final Office Action dated July 22, 2008, as:

A. Whether claims 5, 13-14, 21, 28-30 and 32-40 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 4,148,168 to Diamond (hereafter, "Diamond") in view of U.S. Patent No. 6,220,329 to King et al. (hereafter, "King") and U.S. Patent No. 6,174,403 to Steiner, Jr. et al. (hereafter "Steiner").

III. Argument

A. Rejection of claims 5, 13-14, 21, 28-30 and 32-40 as being unpatentable under 35 U.S.C. §103(a) over Diamond in view of King and Steiner.

1. King does not disclose a starter shingle. The Examiner notes, on page 5 of the Examiner's Answer dated September 29, 2009, that the claim rejections are based on a combination of three references and not just the King reference alone. Appellant agrees with the Examiner that the rejection of the claims is based on a combination of three references and not just the King reference along. However, of the three cited references, Appellant asserts the Examiner has consistently relied on the King reference to provide a starter shingle (on page 3 of the Office Action dated January 12, 2007, on page 3 of the Office Action dated July 9, 2007, on page 3 of the final Office Action dated July 22, 2008 and on page 4 of the Examiner's Answer dated September 29, 2009). Appellant further asserts, for the reasons stated in Appellant's Appeal Brief, that the King reference does not disclose a starter shingle.

2. King discloses a covering shingle. The Examiner argued, on page 6 of the Examiner's Answer dated September 29, 2009, that King does not disclose that his shingle is a starter shingle or a covering shingle because the shingle disclosed in King is not limited to be used as either a starter shingle or covering shingle alone. Further to this assertion, the Examiner argues there has to be a shingle starting at the eaves edge and the King shingle can be the shingle starter. Appellant agrees with the Examiner that there has to be a shingle starting at the eaves edge. However, as provided on page 9 of Appellant's Appeal Brief, there is a structural difference between a covering shingle and a starter shingle. Further, Appellant asserts the shingle disclosed in the King reference does not have the required structure of a starter shingle. Rather the shingle disclosed in the King reference has the structure of a covering shingle. Further, as provided on page 10 of Appellant's Appeal Brief, the shingle disclosed in the King reference cannot function as a starter shingle.

3. King cannot function as a starter shingle. The Examiner asserts on page 7 of the Examiner's Answer dated September 29, 2009, that the required structure and function of a starter shingle (as provided on pages 9 and 10 of Appellant's Appeal Brief) are not supported by a manual, reference book or expert in the art in the form of an affidavit or declaration. Appellant asserts the unique structure and function of a starter shingle are supported by Appellant's Specification beginning on page 2. Additionally, Appellant asserts those skilled in the art understand the unique structure and function of starter shingles. In fact, the unique structure and function of starter shingles have been well documented for time tested roofing systems pre-dating asphalt based roofing systems, such as the requirement for starter shingles for use with slate-based and cedar shake-based roofing systems. As one example, cedar shake-based roofing systems require a double or triple first course of cedar shake shingles as the starter course.

4. King is not a laminated layer. The Examiner asserts on page 7 of the Examiner's Answer dated September 29, 2009, that King is not the only reference and that Steiner provides a laminated shingle. As noted above, Appellant agrees with the Examiner that the rejection of the claims is based on a combination of three references and not just the King reference along. However, in a manner similar to King, Steiner provides a laminated shingle having a single thickness layer positioned under tabs. Appellant asserts that no combination of King and Steiner discloses a laminated starter shingle and further that the combination of the King and Steiner shingles does not disclose a shingle that can function as a starter shingle.

5. King is inoperable as, and cannot be modified to be, a starter shingle. On pages 7 and 8 of the Examiner's Answer, the Examiner continues to assert the King reference is not used alone and is not the base reference. However, as noted above, the Examiner has consistently relied upon the King reference to provide a starter shingle. For at least the reasons discussed above, the King reference fails to disclose the structure of a laminated starter shingle as provided in Appellant's independent claims. Additionally, for the reasons discussed in Appellant's Appeal Brief, the cited references, taken alone or in combination, fail to disclose the starter shingle as provided in Appellant's independent claims.

6. The combined teachings do not provide for a laminated starter shingle. On page 8 of the Examiner's Answer, the Examiner further states the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In response, Appellant asserts that the prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091. One of ordinary skill in the art would not combine the cited references to form a starter shingle as any combination of the Diamond, King and Steiner references would result in areas of a starter shingle having a single thickness. As noted in Appellant's Appeal

Brief on page 9, starter shingles must have a minimum of two layers of shingle material at all locations on the roof. Accordingly, Appellant asserts Appellant's independent claims are not obvious under any combination of the Diamond, King and Steiner references.

Conclusion

For at least the reasons discussed above, Appellant requests that the Board of Patent Appeals and Interferences reverse the Examiner as to all rejections.

Respectfully submitted,

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